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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,589	08/25/2003	Ricky W. Purcell	1443.054US1	4251

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EXAMINER

PAPAPIETRO, JACQUELINE M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/648,589	Applicant(s) PURCELL ET AL.	
	Examiner Jacqueline Papapietro	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/25/2003 and 11/12/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 21, 23, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Daneshvar (Pun. No. 2003/0149389 A1).

Regarding claim 1, Daneshvar discloses a flexible wrap (STR) for supporting a portion of a body, the flexible wrap comprising: an elastic band (paragraph 0006 lines 11-12); and an adhesive mounted on said elastic band near an end of said elastic band to secure said elastic band to a body, wherein the adhesive is adapted to be detachably mounted to the body (paragraph 0110).

Regarding claim 2, Daneshvar discloses the flexible wrap of claim 1 further comprising a releasable cover mounted on said adhesive, wherein said releasable cover is removed to expose said adhesive (paragraph 0111).

Regarding claim 3, Daneshvar discloses the flexible wrap of claim 1 wherein said adhesive is an adhesive layer that extends between lateral edges of said elastic band along said end of said elastic band (paragraph 0106).

Regarding claim 4, Daneshvar discloses the flexible wrap of claim 1 wherein said adhesive is adapted to be detachably mounted to skin on the body (paragraph 0110).

Regarding claim 6, Daneshvar discloses the flexible wrap of claim 1 wherein said elastic band includes a plurality of layers (paragraph 0437).

Regarding claim 21, Daneshvar discloses a method of supporting a portion of a body, the method comprising: attaching an elastic band (paragraph 0006 lines 11-12) to the body using an adhesive (paragraph 0447); and wrapping the elastic band around the portion of the body (Figure 6C).

Regarding claim 23, Daneshvar discloses the method of claim 21 wherein attaching an elastic band to the body using an adhesive includes attaching an end of the elastic band to the body (paragraph 0447).

Regarding claim 25, Daneshvar discloses the method of claim 21 wherein attaching an elastic band to the body using an adhesive includes exposing the adhesive (paragraphs 0110 and 0111).

Claims 7-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Chalek (PN 6936018 B2).

Regarding claim 7, Chalek discloses a flexible wrap (10, column 4 line 46) for supporting a portion of the body, the flexible wrap comprising: and elastic band (12, column 4 line 46); and a plurality of fingers (26) extending from an end of said elastic band, wherein said plurality of fingers are secured to an exposed section of said elastic band when the flexible wrap is attached to the body (column 5 lines 25-26).

Regarding claim 8, Chalek discloses the flexible wrap of claim 7 further comprising a plurality of fasteners (26) wherein at least some of the fingers includes at least one fastener for securing said plurality of fingers to said exposed section of said elastic band (column 5 lines 25-26).

Regarding claim 9, Chalek discloses the flexible wrap of claim 8 wherein each of the fingers includes at least one fastener (26) for securing said plurality of fingers to said exposed section of said elastic band (column 5 lines 25-26).

Regarding claim 10, Chalek discloses the flexible wrap of claim 7 wherein each of said plurality of fingers is integral with the elastic band (Fig 1, column 5 lines 18-19).

Regarding claim 11, Chalek discloses the flexible wrap of claim 10 wherein said plurality of fingers includes at least one finger that extends from said end of said elastic band along a lateral edge of said elastic band and at least one other finger that extends from said end of said elastic band along an opposing lateral edge of said elastic band (Fig 1).

Regarding claim 12, Chalek discloses the flexible wrap of claim 11 wherein said plurality of fingers includes at least one finger that extends from a midsection of said end on said elastic band (Fig 1).

Claims 21-22, 24, and 26-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Peterson (PN 5538500).

Regarding claim 21, Peterson discloses a method of supporting a portion of a body, the method comprising: attaching an elastic band (12, column 3 lines 16-17) to

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the body using an adhesive (28, column 4 line 66-column 5 line 6); and wrapping the elastic band around the portion of the body (Figs 4 and 5).

Regarding claim 22, Peterson discloses the method of claim 21 further comprising securing an end of the elastic band (16b and 18b) to an exposed section of the elastic band (16a and 18a, Fig 4).

Regarding claim 24, Peterson discloses the method of claim 21 wherein attaching an elastic band to the body using an adhesive includes attaching the adhesive to skin on the body (28, column 5 lines 1-2).

Regarding claim 26, Peterson discloses a method of supporting a portion of a body, the method comprising: wrapping and elastic band (12, column 3 lines 16-17) around the portion of the body (column 3 lines 57-58); and securing a plurality of fingers that project from an end of the elastic band (16b and 18b) to an exposed section of the elastic band (16a and 18a).

Regarding claim 27, Peterson discloses the method of claim 26 further comprising repositioning at least one of the plurality of fingers to customize pressure applied by the elastic band (column 3 lines 62-65).

Regarding claim 28, Peterson discloses the method of claim 27 wherein repositioning at least one of the plurality of fingers includes disengaging the at least one of the plurality of fingers from the elastic band and then securing the at least one of the plurality of fingers to another part of the elastic band (column 3 lines 60-65).

Regarding claim 29, Peterson discloses the method of claim 26 further comprising attaching the elastic band to the body (column 4 line 66-column 5 line 6).

Regarding claim 30, Peterson discloses the method of claim 29 wherein attaching the elastic band to the body includes attaching the elastic band to skin on the body using an adhesive (28).

Regarding claim 31, Peterson discloses the method of claim 26 wherein wrapping an elastic band around the portion of the body includes wrapping the elastic band around the body more than one time but less than two times (Fig 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daneshvar as applied to claim 1 above, and further in view of Hymes (PN 6455065 B1) and Podell et al (PN 5620702).

Daneshvar discloses the flexible wrap of claim 1, but does not disclose the wrap wherein the adhesive is a hydrogel. Hymes teaches an acne patch (10) attached to the skin with a hydrogel adhesive (14). Podell et al teaches a bandage (10) with a hydrogel adhesive (column 5 lines 2-3). Hydrogel is a standard type of adhesive used in medicine and medical applications. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included hydrogel adhesives in the range of adhesives acceptable for use in the Daneshvar invention.

Claims 13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson.

Regarding claim 13, Peterson discloses a flexible wrap for supporting a portion of a body, the flexible wrap (10) comprising: an elastic band (14) having a first end and a second end; an adhesive layer mounted on said elastic band (28) to secure said elastic band to a body, wherein said adhesive layer is adapted to be detachably mounted to skin on the body; a plurality of fingers extending from said second end of said elastic band (16b and 18b), wherein said plurality of fingers are integral with said elastic band and secured to an exposed section of said elastic band (16a and 18a) when the flexible wrap is attached to the body; and a plurality of fasteners, wherein each finger includes at least one fastener for securing said plurality of fingers to said exposed section of said

elastic band (20 and 22). Peterson does not disclose having the adhesive layer near the first end.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive at an end of the elastic band in order to secure the flexible wrap to the skin at an end of the wrap instead of in the middle.

Regarding claim 15, Peterson discloses a flexible wrap (10) for supporting a portion of a body, the flexible wrap comprising: an elastic band (14); a pack (24) that includes a midsection; and a fastener extending along the edges of said pack such that said fastener secures said pack to said elastic band (Fig 1). Peterson does not disclose a fastener along the midsection of the pack, but does teach that the pack need not be secured to the wrap entirely around its circumference (column 4 lines 15-17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive layer so it extends along the midsection of the pack in order to reduce the amount of adhesive needed to secure the pack to the elastic band or to reduce the complexity required during the manufacturing of the invention.

Regarding claim 16, Peterson teaches the flexible wrap of claim 15, as described above, wherein said fastener is an adhesive (column 4 line 13).

Regarding claim 17, Peterson teaches the flexible wrap of claim 16, as described above, wherein said adhesive is an adhesive layer that extends between opposing

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edges of said pack on two sides of the pack (column 4 lines 17-18). Peterson does not disclose a single adhesive layer that extends along the midsection of the pack.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive layer so it extends along the midsection of the pack in order to reduce the amount of adhesive needed to secure the pack to the elastic band or to reduce the complexity required during the of manufacturing the invention.

Regarding claims 18 and 19, Peterson teaches the flexible wrap of claim 17, as described above, wherein the elastic band includes lateral edges (Fig 1), but does not specifically disclose the flexible wrap wherein the adhesive layer is transverse to said lateral edges when the pack is secured to said elastic band or wherein said adhesive layer extends between said lateral edges. However, Peterson teaches that the pack may be secured only on two sides or the four corners (column 4 lines 17-18). Another obvious option would be to secure the pack by placing an adhesive layer so it extends along the midsection of the pack, as described above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Peterson invention so that said adhesive layer is transverse to said lateral edges and said adhesive layer extends between said lateral edges when said pack is secured to said elastic band in order to secure the pack to the elastic band in the best mode when the wrap is attached to the body (Figs 4 and 5) while using an adhesive layer along the midsection of the pack.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson as applied to claim 13 above, and further in view of Daneshvar.

Peterson discloses the flexible wrap of claim 13, as described above, but does not disclose the wrap wherein the elastic band includes a plurality of layers. Daneshvar teaches a flexible wrap with an elastic band with an adhesive layer and a plurality of fasteners to secure the elastic band around the portion of the body, wherein the elastic band includes a plurality of layers (paragraph 0437). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson in view of Daneshvar by making the elastic band out of a plurality of layers in order to provide a stronger elastic band.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson as applied to claim 16 above, and further in view of Hymes (PN 6455065 B1) and Podell et al (PN 5620702).

Peterson discloses the flexible wrap of claim 16, but does not disclose the wrap wherein the adhesive is a hydrogel. Hymes teaches an acne patch (10) attached to the skin with a hydrogel adhesive (14). Podell et al teaches a bandage (10) with a hydrogel adhesive (column 5 lines 2-3). Hydrogel is a standard type of bandage-skin adhesive used in medicine and medical applications. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included hydrogel adhesives in the range of adhesives acceptable for use in the Peterson invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Scholl PN 2740402.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline Papapietro whose telephone number is (571) 272-1546. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMP.

Jacqueline Papapietro
Art Unit 3739


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PRIMARY EXAMINER